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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,844	11/19/2001	Mark David Siegel	23679-7005	4461

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MCCUTCHEN, DOYLE, BROWN & ENERSEN  
Suite 1800  
Three Embarcadero Center  
San Francisco, CA 94111-4067

EXAMINER
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COBURN, CORBETT B

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/042,844	<b>Applicant(s)</b> SIEGEL ET AL.	
	<b>Examiner</b> Corbett B. Coburn	<b>Art Unit</b> 3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 and 23-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 23-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-17 & 23-44 are rejected on the ground of nonstatutory double patenting over claims 1-18 of U. S. Patent No. 6,709,336 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Claim 1 of the patent claims a game in which barcodes are scanned from products to be used as character data in a computer game. Claim 1 in the instant application is a generic device for scanning barcodes from products

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to be used as character data in a computer game. The patented method renders a device to carry out that method obvious.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 16 recites the limitation "the second gaming device" in the last two lines. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-6, 11, 12, 14, 15 & 30-34 rejected under 35 U.S.C. 102(b) as being anticipated by Ebisawa (JP 2000308,763).

**Claim 1:** Ebisawa teaches a gaming device (32) with a scanner (40) for scanning a barcode corresponding to a product identification (paragraph 0001). There is a

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processing means (38) for receiving the barcode from the scanner. The processor translates the barcode into game data and determines whether the game data are compatible game data. There is a storage medium for storing the compatible game data. (0009)

**Claim 2:** The game data is character data. (0010)

**Claim 3:** The gaming device is a handheld gaming device. (Figs 4 & 9)

**Claim 4:** The scanner (40) inherently has a light-emitting diode.

**Claim 5:** There is a screen (25 or 44) for displaying a menu (Fig 6 & 0118) according to signals from the processor (38).

**Claim 6:** The storage medium includes a look-up table ("stock information") to which the processor (40) refers when it translates the barcode into game data. The look-up table correlates a plurality of different barcodes to a plurality of different game data. (0013-0018 & 0059-0060)

**Claim 11:** Ebisawa's gaming device includes a speaker. (26 & paragraph 0046)

**Claims 12, 14 & 15:** Ebisawa teaches that the processing means determines when the game data are incompatible game data (i.e., data corresponding to enemy characters) (0035 & 0061) and determines whether a contest (a battle) will be staged on the screen based on that determination (i.e., waging-war mold [sic]). (0073)

**Claims 30-34:** Ebisawa teaches a barcode on an arbitrary household product that is unrelated to the gaming device (i.e., a can of juice) that identifies a company and the product sold by the company. (0055-56) The barcode is translated into gaming data related to the gaming device.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebisawa as applied to claim 1.

**Claims 7-10:** Ebisawa teaches reading barcodes but does not teach European Article Numbering code, Universal Product Code, Global Trade Item Number code and Global Location Number code, are all equivalent types of barcodes and are disclosed as such by Applicant. They are equivalent to the JAN disclosed by Ebisawa. (0052) They are used to mark products in different parts of the world. For instance, the EAN is preferred for use in Europe. The UPC is used in the United States. It would have been obvious to one of ordinary skill in the art to have used one (or all) of the above mentioned barcode formats to allow players in different parts of the world to use the invention.

9. Claims 13, 16, 17, 23-29 & 35-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebisawa as applied to claim 1 or 12 in view of Ng (US Patent Number 5,971,855).

**Claims 13 & 16:** Ebisawa teaches the invention substantially as claimed, including graphically displaying a battle between characters represented by compatible and incompatible data. Ebisawa appears to teach linking gaming machines via a communications port (Fig 10), but due to the poor quality of the

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machine translation, Examiner cannot be certain. Ng clearly teaches to teach linking gaming machines via a communications port (Fig 1A & Abstract) in order to facilitate play between two players. This increases the enjoyment to be had from the gaming device. (Col 2, 57-60) It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Ebisawa in view of Ng to link gaming machines via a communications port in order to facilitate play between two players, thus increasing the enjoyment to be had from the gaming device.

**Claims 17, 24:** Ng's communication port has a first tab for fitting into a first slot of the second gaming device and a second slot for receiving a second tab of the second gaming device (Fig 1A) and a plurality of contacts for transmitting data between the two gaming devices. (Col 3, 15 & 16)

**Claim 23:** Claim 23 is a combination of claims 1-4 & 16, which see.

**Claims 25 & 26:** The physical shape and color of the case (i.e., in the form of a logo associated with and a color associated with the game data) are a matter of aesthetic design choice. A red case is not patentably distinct from a blue case, nor is one with a particular logo patentably distinct from a case with another logo.

**Claim 27:** Both Ebisawa and Ng have screens and buttons on one side of the case. Ebisawa teaches the display of menus (Fig 6) and by necessity selecting choices from the menu using the control buttons.

**Claim 28:** Ng's coupling device is disposed on a first side of the case. (Fig 1A)

**Claim 29:** Claim 29 is a combination of claims 1, 2, 6, 8, & 16, which see.

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**Claims 35-39:** Ebisawa teaches a barcode on an arbitrary product that is unrelated to the gaming device (i.e., a can of juice) that identifies a company and the product sold by the company. (0055-56)

**Claims 40-44:** Ebisawa teaches the use of JAN instead of UPC. As discussed above in connection with claims 7-10, JAN and UPC are obvious equivalents.

***Response to Arguments***

10. Applicant's arguments with respect to claims 1-17 & 23-29 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Reference Name	Identification Number	Relevance
Hara	US 5,212,368	Barcode reader for game
Chagoll et al	US 5,269,522	Reads barcodes from products to play game
Peppel	US 2001/0039206	Reads barcodes to play game
Weston	US 6,761,637	Reads barcodes to play game
Saito	JP 2000317035	Reads barcodes from products to play game
Ebisawa	JP 02000308762	Reads barcodes from products to play game

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Jones can be reached on (571) 272-4438. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Corbett B. Coburn', with a stylized flourish at the end.

Corbett B. Coburn  
Examiner  
Art Unit 3714